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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,941	03/31/2004	Shinji Miyabayashi	58799-105	4925

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McDermott, Will & Emery
600, 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

FOUD, HICHAM B

ART UNIT	PAPER NUMBER
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2616

MAIL DATE	DELIVERY MODE
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08/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/812,941

Applicant(s)

MIYABAYASHI ET AL.

Examiner

Hicham B. Foud

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 03/31/2004
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. It is noted that this application appears to claim subject matter disclosed in prior Application No. JP 2003-183737, filed 06/27/2003. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference

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required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6 line 7, the term "the management server" has no antecedent basis.

In claim 7, the recitation "forwards a request for activating the fourth wireless transmitter/receiver to the third wireless transmitter/receiver if the authentication succeeds" is vague because it is not clear what the applicant means by activating the fourth wireless transceiver to the third wireless transceiver. Also, in line 19, the term "the communication terminal" is indefinite because they are two communication terminals claimed.

Claim 8 is rejected because it depends on the rejected claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Csapo (US 2003/0202497) in view of Feder et al (US 2004/0142693) hereinafter is referred to as Hulkkonen.

For claim 1, Csapo discloses a communication terminal, comprising: a first transmitter/receiver which transmits and receives data according to a first communication method (see Figure 4 element 411; CDMA2000 transceiver); a second transmitter/receiver which transmits and receives data according to a second communication method (see Figure 4 element 410; 802.xx Transceiver). Csapo further discloses a controller, which operates to activate the second transmitter/receiver when the signal of the first transmitter/receiver is lost (see Figure 4 element 440; Main processor and see paragraph 0044; If the IEEE 802.xx wireless network is subsequently lost, mobile station switches to CDMA2000 mode). Csapo does not explicitly show a controller which operates to activate the second transmitter/receiver when the first transmitter/receiver receives a request for activating the second transmitter/receiver, but that may be inherent in Csapo invention since the switching from one mode to the other is based on a handover method. However, Feder from the same or similar field of endeavor teaches that a multi-mode mobile can be handed over a second network when the handoff conditions are met by receiving a handover command which is equivalent to a request to switch to the second transmitter/receiver (see Figure 1, how the mobile station can be connected to 4 different networks and see Figure 2 steps S80

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and S90; wherein when handoff conditions are met, the mobile uses the selected network as a serving network). Thus, it would have been obvious to the one skill in the art at the time of the invention to use the handover method as taught by the invention of Feder into the invention of Csapo for the purpose of connecting to a second network before final disconnection from a first network and to be able to adapt to the second network and exchange data.

Claim 4 is rejected for same reasons as claim 1.

For claim 2, Csapo further discloses a communication terminal, wherein the controller operates to activate the first transmitter/receiver when electric power is applied to the communication terminal (see paragraph 0044 lines 8-9; mobile station operates in a preferred 802.xx mode; inherently when mobile is powered up, it uses the preferred mode because it is the default mode). Csapo further discloses suspend operation of the second transmitter/receiver until the signal of the first transmitter/receiver is lost (see Figure 4 element 440; Main processor and see paragraph 0044; If the IEEE 802.xx wireless network is subsequently lost, mobile station switches to CDMA2000 mode). Csapo does not explicitly show a controller which operates to suspend operation of the second transmitter/receiver until the first transmitter/receiver receives a request for activating the second transmitter/receiver, but that may be inherent in Csapo invention since the switching from one mode to the other is based on a handover method. However, Feder from the same or similar field of endeavor teaches that a multi-mode mobile can be handed over a second network when the handoff conditions are met by receiving a handover command which is

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equivalent to a request to switch to the second transmitter/receiver (see Figure 1, how the mobile station can be connected to 4 different networks and see Figure 2 steps S80 and S90; wherein when handoff conditions are met, the mobile uses the selected network as a serving network). Thus, it would have been obvious to the one skill in the art at the time of the invention to use the handover method as taught by the invention of Feder into the invention of Csapo for the purpose of connecting to a second network before final disconnection from a first network and to be able to adapt to the second network and exchange data.

For claim 3, Csapo discloses a communication terminal, wherein the first transmitter/receiver is connectable to a wireless base station in a mobile network (see Figure 4 element 411; CDMA2000 transceiver), while the second transmitter/receiver is connectable to a wireless LAN (Local Area Network) base station (see Figure 4 element 410; 802.xx Transceiver).

For claim 5, Feder discloses a communication terminal, wherein the first transmitter/receiver forwards a notification indicating that the second transmitter/receiver is not able to transmit and receive data, when the first transmitter/receiver has received the data representing the request for the communication by the second transmitter/receiver and the communication by the second transmitter/receiver is not possible (see Figure 1, how the mobile station can be connected to 4 different networks and see Figure 2 steps S80 and S10; wherein "when handoff conditions are not met, the mobile scans environment for available systems"; Inherently, when the mobile is about to be handover to a second network, it receives a

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handoff command that is equivalent to a request to switch to the second network, however when the second network is not available because of some reasons (handoff conditions), then the mobile goes back to scan the environment).

For claim 6, Feder discloses a communication terminal, further comprising: a memory which stores identification data of the communication terminal (see Figure 1 the mobile station; inherently, the mobile station comprises a memory that has its identification data stored in it because it needs to send these information to the base station for authentication when setting up a connection); wherein the first transmitter/receiver operates to transmit the identification data of the first communication terminal to the management server (see Figure 1 and Figure 2 the handoff method; inherently, before handoff or, even before the connection to the first network, the mobile has to send identification data to the base station for authentication and identification), when a user inputs a request for a communication by utilizing the second transmitter/receiver (see paragraph 0056 lines 1-3; a mobile user can specify a set of preferences for a handover; Therefore, the user can choose who to connect to which is equivalent to the request).

Allowable Subject Matter

5. Claims 7 and 8 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

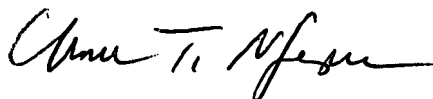
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hicham B. Foud whose telephone number is 571-270-1463. The examiner can normally be reached on Monday - Thursday 10-3 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau T. Nguyen can be reached on 571-272-3126. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Hicham Foud



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